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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/982,157
Filing Date	October 17, 2001
First Named Inventor	William R. Perrault
Group Art Unit	1626
Examiner Name	Golam Shameen
Total Number of Pages in This Submission	
Attorney Docket Number	28341/6301.N

ENCLOSURES (*check all that apply*)

☐ Fee Transmittal Form	☐ Assignment Papers *(for an Application)*	☐ After Allowance Communication to Group
☐ Fee Attached	☐ Drawing(s)	☐ Appeal Communication to Board of Appeals and Interferences
☐ Amendment/Reply	☐ Licensing-related Papers	☐ Appeal Communication to Group *(Appeal Notice, Brief, Reply Brief)*
☐ After Final	☒ Petition	☐ Proprietary Information
☐ Affidavits/declaration(s)	☐ Petition to Convert to a Provisional Application	☐ Status Letter
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☐ Response to Missing Parts/ Incomplete Application	Remarks	
☐ Response to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm *or* Individual Name	MARSHALL, GERSTEIN & BORUN LLP MARK H. HOPKINS, Ph.D.
Signature	
Date	JULY 28, 2003

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Dated: July 28, 2003 Signature: _____ (Mark H. Hopkins, Ph.D.)

PATENT
28341/6301.N

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

In re Application of: Perrault *et al.*

Serial No.: 09/982,157

Filed: October 17, 2001

Title: "Methods for Producing Oxazolidinone Compounds"

Group Art Unit: 1626

Examiner: G. Shameem

CERTIFICATE OF MAILING
(37 CFR 1.8)

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Mark H. Hopkins, Ph.D.

PETITION FOR RECONSIDERATION OF RESTRICTION REQUIREMENT UNDER 37 C.F.R. §§ 1.13 AND 1.81

Mail Stop Petition
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This petition is submitted under 37 C.F.R. §§ 1.13 and 1.81 to request reconsideration of the restriction requirement in an official action dated March 20, 2003 and the examiner's denial in a subsequent official action dated May 28, 2003, of the petitioners' proper request for reconsideration under 37 C.F.R. § 1.111 dated November 13, 2000. This petition is timely filed, and the fee of $130.00 due under 37 C.F.R. § 1.17(h) is enclosed herewith. The petitioners respectfully petition for reconsideration in view of the following remarks.

I. STATEMENT OF THE FACTS INVOLVED

A. The Requirement for Restriction

In the official action dated March 20, 2003, restriction was required between the following groups, as well as nine others:

Group IX, claims 32-33 and 36-40, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses;

Group X, claims 34-35, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses;

Group XI, claims 41-42 and 45-48, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses;

Group XII, claims 43-44, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses;

Group XIII, claims 49-50 and 53-56, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses;

Group XIV, claims 51-52, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses;

Group XVI, claims 58, drawn to a method of preparing an oxazolidinone of a formula, classified in class 548 with several subclasses.

The restriction requirement is attached as **Exhibit 1**. The pending claims are attached as **Exhibit 2**. The pending amendment filed concurrently is attached as **Exhibit 3**.

The examiner stated that the respective processes of Groups VI-XIV and XVI are distinct because "each process has different reactive steps and conditions. Also the fields of search are not coextensive."

B. The Petitioners' Response

The petitioners' proper response and request for reconsideration under 37 C.F.R. § 111 requested withdrawal of the restriction requirement because the standard for requiring restriction had not been met. The claims of Groups IX-XIV and Group XVI are related as combination and subcombination and distinctiveness only exists for inventions of

this nature if it can be shown that (1) the combination claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (M.P.E.P. § 806.05(c)). The petitioners argued that the Patent Office did not meet its own standard for restricting the combination from the subcombination, and therefore, the restriction should not be required. The petitioners also argued that the search and examination of the entire application could be made without serious burden on the examiner. Finally, the petitioner's response also presented arguments that the standard for requiring restriction also has not been met because the examiner has not shown, by appropriate explanation, reasons for insisting on restriction.

To satisfy 37 C.F.R. 1.143, the applicants provisionally elected for examination on the merits, with traverse, the claim of Group XVI, i.e., claim 58.

C. The Examiner's Response

In a telephone conversation between the examiner and the undersigned on May 7, 2003, and in the official action of May 28, 2003, the examiner notified the undersigned of the allowance of claim 58. The examiner noted the applicants' traversal but did not find it persuasive "because the products of groups I to XVI (outlined in paper No. 10) differ materially in structure and element from each other and are capable of supporting their own patent." (See Exhibit 1, page 2). The undersigned discussed with the examiner that claims 32-56 should properly be issued with claim 58 and faxed an informal amendment to the examiner on May 15, 2003 and July 16, 2003. These informal amendments do not appear to have been considered by the Patent Office.

II. POINTS TO BE REVIEWED

A. The petitioners hereby request review and withdrawal of the requirement for restriction, particularly on the bases that: (1) restriction is not proper because the inventions of Groups XVI and IX-XIV are variously related as combination and subcombinations, and the criteria for distinctiveness have not been met; (2) claim 58 defines the same essential characteristics of the claims of Groups IX-XIV; and (3) generic claim 58 is allowable in substance.

1. Restriction Is Not Proper Because the Inventions of Groups XVI and IX-XIV Are Variously Related as Combination and Subcombinations, and the Criteria for Distinctiveness Have Not Been Met.

Section 806.05(a) of the M.P.E.P. states: "A combination is an organization of which a subcombination or element is a part." The claim of Group XVI is directed to a method of making an oxazolidinone compound by any of 3 different submethods. The claims of Group IX and X are directed to the first of those submethods; the claims of Group XI and XII are directed to the second of those submethods; and the claims of Group XIII and XIV are directed to the third of those submethods (*See* Exhibit 2.) The inventions of Groups IX and XVI are related as subcombination and combination, respectively. Likewise, the inventions of Groups XI and XVI are related as subcombination and combination, respectively. Further, the inventions of Groups XIII and XVI are related as subcombination and combination respectively. Inventions in this relationship are only distinct if it can be shown that (1) the combination claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (M.P.E.P. § 806.05(c)).

To justify the restriction requirement, the examiner has taken the position, that each process has different reactive steps and conditions. Not only is this incorrect, it is not the relevant inquiry for restriction analysis under 35 U.S.C. §121. The M.P.E.P. *requires* that "the burden is on the examiner to suggest an example of separate utility" (See M.P.E.P., §806.05(c)). The Patent Office has not even alleged separate utility.

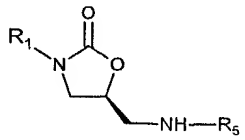
Thus, the standard for restricting the subcombination of Group I from the combination of Group II is not proper on the grounds that the criteria of distinctiveness in M.P.E.P. § 806.05(c) have not been met. This examiner ignores the required criterion of distinctiveness in M.P.E.P. § 806.05(c), that inventions are distinct only "if it can be shown that a combination *as claimed*: (A) does not require the particulars of the subcombination *as claimed* for patentability ..." The effect of the patent office's position *vis à vis* the requirement for restriction are various admissions concerning patentability, *e.g.*, that the effect of the restriction requirement, unless withdrawn, is that the Patent Office admits that claim 58 is patentable over any disclosure of a method according to the Group IX-XIV claims.

2. Restriction is Not Proper Because Claim 58 defines the same essential characteristics of the claims of Groups IX-XIV.

In addition, M.P.E.P. § 806.03 advises that:

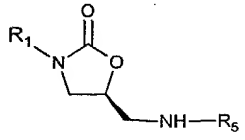
> "where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth and scope of definition."

Under these requirements, the restriction between Groups IX-XIV and XVI is improper. Each of claims 32-56 is directed to a method of making an oxazolidinone compound. Independent claim 32, and its dependent claims 33 and 36-40, which are classified in Group IX, specify a method of preparing an oxazolidinone having a general structural formula:



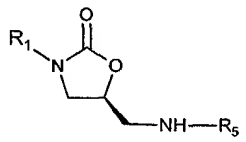
Dependent claims 34 and 35, which are classified in Group X, are also directed to a method of preparing an oxazolidinone having the above formula, and more particularly recites particular aryl substituents. Claims 34 and 35 are identical to claim 32, but include the additional recitation of particular aryl substituents. The additional recitation included in claims 34 and 35 serves to more particularly specify the aryl substituent. Accordingly, claims 32-40 all specify method of preparing an oxazolidinone, albeit with varying breadth and scope with regard to substituents. Restriction between the claims of Groups IV and VIII, therefore, is improper.

Likewise, independent claim 41, and its dependent claims 42 and 45-48, which are classified in Group XI, specify a method of preparing an oxazolidinone having a general structural formula:



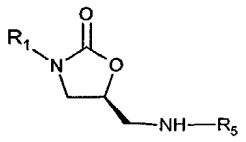
Dependent claims 43 and 44, which are classified in Group XII, are also directed to a method of preparing an oxazolidinone having the above formula, and more particularly recite particular aryl substituents. Claims 43 and 44 are identical to claim 41, but include the additional recitation of particular aryl substituents. Accordingly, claims 41-48 all specify a method of preparing an oxazolidinone, albeit with varying breadth and scope with regards substituents. Restriction between the claims of Groups XI and XII, therefore, is improper.

Likewise, independent claim 49, and its dependent claims 50 and 53-56 which are classified in Group XIII, specify a method of preparing an oxazolidinone having a general structural formula:



Dependent claims 51 and 52, which are classified in Group XIV, are also directed to a method of preparing an oxazolidinone having the above formula, and more particularly recite particular aryl substituents. Claims 43 and 44 are identical to claim 49, but include the additional recitation of particular aryl substituents. Accordingly, claims 49-56 all specify a method of preparing an oxazolidinone, albeit with varying breadth and scope with regards substituents. Restriction between the claims of Groups XIII and XIV, therefore, is improper.

Finally, independent claim 58, which is classified in Group XVI, specifies a method of preparing an oxazolidinone having a general structural formula:



Independent claims 32, 41, and 49, which are classified in Groups IX, XI, and XIII, are also directed to a method of preparing an oxazolidinone having the above formula, and more particularly recite certain intermediates also recited in claim 58. Claims 32, 41, and 49 are identical to claim 58, but include only the recitation of particular intermediates. Accordingly, claims 32-56 and 58 all specify a method of preparing an oxazolidinone, albeit

with varying breadth and scope with regard to substituents and intermediates. Restriction between the claims of Groups IX-XIV and XVI, therefore, is improper.

3. Restriction is Not Proper Because Generic Claim 58 is allowable in substance.

In addition, M.P.E.P. § 806.02(e) advises that:

> "Whenever a generic claim is found to allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim were allowed. The treatment of the application should be as indicated in MPEP §809.03(b), §809.02(c), or §809.02(d)."

The inventions of Groups IX-XIV are species claims of generic claim 58. Because species claims are presented and an election of a single species has been made, §809.02(c) applies. Under §809.02(c)(B)(1), when all claims to each of the additional species are embraced by an allowable generic claim as provided by 37 CFR 1.141, applicant must be advised of the allowable generic claim and that claims drawn to the non-elected species are no longer withdrawn since they are fully embraced by the allowed generic claim. Restriction and withdrawal of the claims of Groups IX-XIV and XVI, therefore, is improper.

III. ACTION REQUESTED

For the reasons set forth above, the petitioners hereby respectfully request the Patent Office withdraw the requirement for restriction with regard to the amended claims and allowance of all pending claims in the application. Should the Commissioner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, the Commissioner is urged to telephone the undersigned at the indicated number.

Respectfully submitted,

MARSHALL GERSTEIN & BORUN LLP
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233 South Wacker Drive
Chicago, Illinois 60606-6402

July 28, 2003

By: _____

Mark H. Hopkins, Ph.D.
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